

**REMARKS**

Applicant submits this Amendment in reply to the Office Action dated October 22, 2003. As an initial matter, Applicant gratefully acknowledges the Examiner's indication of the allowability of the subject matter of claims 62-64. However, because Applicant believes independent claims 1 and 46, as amended, are allowable over the cited references, Applicant has not rewritten claims 62-64 at this time.

By this Amendment, Applicant has cancelled claims 16, 52, and 53 without prejudice or disclaimer. Applicant has also amended claims 1, 2, 5, 7-9, 17, 18, 24-28, 32-34, 37, 39-41, 43, 46, 53, and 65, and added new claims 89-101. The originally filed specification, drawings, and claims fully support the subject matter of the amended claims and new claims. No new matter has been introduced.

In the Office Action dated May 6, 2003, pending claims 3, 8, 26, 34-42, and 59-61 were withdrawn from consideration as being directed to a nonelected invention. In the present Office Action, claims 49 and 50 were additionally withdrawn from consideration as being nonelected. Applicant does not necessarily agree with the withdrawal of claims 49 and 50. Nonetheless, Applicant respectfully submits that since independent claims 1 and 46 are allowable, as will be explained below, withdrawn dependent claims 3, 8, 26, 34-42, and 59-61 should be rejoined and also allowed.

In the Office Action, claims 1, 2, 4-7, 9, 13, 14, 16-19, 23-25, 27-33, 46-48, 52-55, 57, 58, and 65 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0077566 to LaRoya et al. ("LaRoya"); claims 10-12 and 43-45 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,290,728 to Phelps et al. ("Phelps"); and claims 15, 20-22, 51, and 56

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were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,029,672 to Vanney et al. ("Vanney"). Applicant respectfully requests the withdrawal of these rejections because none of the cited references, whether taken individually or in combination, discloses or otherwise suggests each and every aspect of the claims as amended.

Claims 1 and 46 are the sole rejected pending independent claims. Independent claim 1, as amended, recites a method of treating a heart comprising, among other aspects, "advancing a catheter carrying a stent along the guidewire through the anterior wall and the posterior wall of the coronary vessel and into the heart wall." Independent claim 46, as amended, recites a method of treating a heart comprising, among other aspects, "placing a guidewire through [a] needle past the anterior wall and the posterior wall of the coronary vessel and through a heart wall between the heart chamber and the coronary vessel; inserting an expansion device along the guidewire through the anterior wall and the posterior wall of the coronary vessel and into the heart wall; [and] expanding the expansion device within the heart wall to form a passageway between the heart chamber and the coronary vessel." None of the cited references, whether taken individually or in combination, discloses or otherwise suggests at least the above-quoted aspects of the claims 1 and 46, respectively.

LaRoya discloses methods for delivering devices for placing a coronary vessel in communication with a heart chamber. Figs. 2-8 of LaRoya disclose various methods of delivering a guidewire 120, 120A through an introducer 110, 110A such that a portion of the guidewire traverses a left ventricle 12 and walls of a LAD (left anterior descending artery) 30. Figs. 2-5 disclose running the guidewire 120 through the introducer 110,

through walls of LAD 30, into the heart chamber 12, and then out of the heart chamber 12 through aorta 18. Figs. 6-8 disclose running the guidewire 120A through the introducer 110A, through walls of LAD 30, into the heart chamber 12, lassoing an end of the guidewire 120A with a snare assembly 132, 134, 136 disposed through the heart wall 34 in a lower portion of the heart 10, and then pulling the guidewire 120A out of the heart chamber 12 through the heart wall 34 in the lower portion of the heart 10. In both Figs. 2-5 and 6-8, the proximal and distal ends of the guidewire 120, 120A when delivered, are external to the heart 10.

Figs. 10-18F then disclose various methods of delivering a conduit 142, 172, 202 to the heart wall 34 such that an end portion 152, 188 of the conduit 142, 172, 202 is positioned through LAD lower wall 40 and in the lumen of the LAD 30. Figs. 10-12A disclose running conduit 142 via a shaft 154 over the guidewire 126 through the aorta 18, into the heart chamber 12, and into the heart wall 34 and LAD lumen. The shaft 154 is then removed from the conduit 142 through the heart chamber 12 and the aorta 18. Figs. 14-17A and paragraphs [0062]-[0063] disclose running conduit 172 via a shaft 174 over the guidewire 120A through the heart wall 34 in a lower portion of the heart 10, into the heart chamber 12, and into the heart wall 34 and LAD lumen. A sheath 180 is then removed from the conduit 172 and run out of the heart 10 through the walls 38, 40 of the LAD 30. A balloon 178 carrying the conduit 172 and positioned in the heart wall 34 with an end portion positioned through LAD lower wall 40 and in the LAD lumen is then inflated to expand conduit 172. The balloon 178 is then deflated and removed from the interior of the conduit 172, along with the shaft 174, via the heart chamber 12 and heart wall 34 near an apex of the heart. Figs. 18-18F and paragraph [0069]-[0072] disclose

running conduit 202 into the heart chamber 12 and into the heart wall 34 such that an end portion of the conduit 202 is positioned through LAD lower wall 40 and in the LAD lumen. A balloon 210 is then expanded to inflate a portion 216 of the conduit 202 not covered by a sheath 212. The sheath 212 is then run out of the heart wall 34 via the walls 38, 40 of the LAD 30. Balloon 210 is then further expanded to expand the rest of the conduit 202. The balloon 210 is then deflated and removed from the conduit 202 via the heart chamber 12 and heart wall 34 near the apex of the heart.

As shown in each embodiment of LaRoya, the conduit 142, 172, 202 is delivered to the heart wall 34 and through LAD inner wall 40 by going through the heart chamber 12, rather than through both walls of the LAD 30. Thus, LaRoya neither discloses nor otherwise suggests either “advancing a catheter carrying a stent along the guidewire through the anterior wall and the posterior wall of the coronary vessel and into the heart wall,” as recited in claim 1, or “inserting an expansion device along the guidewire through the anterior wall and the posterior wall of the coronary vessel and into the heart wall [and] expanding the expansion device within the heart wall to form a passageway between the heart chamber and the coronary vessel,” as recited in claim 46.

In the Section 102(e) rejection based on LaRoya, the Examiner also relies on Rapacki, which is incorporated by reference in LaRoya. However, Rapacki fails to disclose or otherwise suggest either “advancing a catheter carrying a stent along the guidewire through the anterior wall and the posterior wall of the coronary vessel and into the heart wall,” as recited in claim 1, or “placing a guidewire through [a] needle past the anterior wall and the posterior wall of the coronary vessel and through a heart wall between the heart chamber and the coronary vessel,” as recited in claim 46. Indeed,

the Examiner does not assert otherwise in the Office Action, but rather relies on Rapacki for its alleged teachings of certain features found in dependent claims 7, 9, 13, and 14.

In the Office Action, the Examiner additionally relies on Phelps and Vanney in combination with LaRoya to reject certain dependent claims. Vanney, however, does not cure the above-noted deficiencies of LaRoya and the Examiner has not asserted otherwise in the Office Action.

With regard to Phelps, Applicant submits that because the Phelps reference is being relied on as prior art under 35 U.S.C. §102(e), and since the present application was filed after November 29, 1999, under the provisions of 35 U.S.C. § 103(c), the Section 103 rejection based on Phelps can be overcome by showing that the subject matter of the Phelps reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. Applicant supplies a statement on a separate sheet of this response, made by Applicant's representatives, regarding the ownership of the present application and the Phelps reference. Applicant respectfully submits that in light of this statement, the Section 103 rejection based on Phelps set forth in the Office Action should be withdrawn.

**Applicant's Representative of Record Statement of Common Ownership**  
**Under M.P.E.P. §706.02(I)(2)**

Under the provisions of M.P.E.P. §706.02(I)(2), Applicant's undersigned representative of record supplies the following statement to the effect that the present application and U.S. Patent No. 6,290,728 B1 to Phelps et al. were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same organization:

U.S. Patent Application No. 09/845,154, filed May 1, 2001, in the name of Peter Boekstegers, and U.S. Patent No. 6,290,728 B1, filed August 4, 1999, in the name of David Y. Phelps et al., were, at the time the invention of U.S. Patent Application No. 09/845,154 was made, both owned or subject to an obligation of assignment to Percardia, Inc.

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Accordingly, for at least the above reasons, the rejections of claims 1 and 46, and their respective dependent claims, should be withdrawn. Furthermore, because claims 1 and 46 are allowable for the reasons explained above, Applicant respectfully requests the rejoinder and allowance of withdrawn claims 3, 8, 26, 34-42, 49, 50, and 59-61.

Applicant has further added new independent claim 101, support for which can be found at least in Figs. 4-7 and the corresponding written description of those figures, for example. Independent claim 101 also is patentably distinguishable from the cited references.

For at least the above reasons, Applicant respectfully requests the withdrawal of the outstanding claim rejections and the timely allowance of pending claims 1-15, 17-51, 54-65, and 89-101.

The Office Action contains characterizations of the claims and the related art, with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

In discussing the specification, claims, abstract, and drawings in this Amendment, it is to be understood that Applicant is in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Please grant any extensions of time required to enter this Amendment and  
charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By: 

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